

REMARKS

Applicants appreciate the Examiner's thorough examination of the present application as evidenced by the Office Action of April 21, 2006 (hereinafter "Office Action").

Applicants especially appreciate the indication that Claims 8, 9, 33, 34, 55, and 56 recite patentable subject matter. *See Office Action, p. 14.* Rather than writing various ones of the foregoing claims in independent form at this time, Applicants respectfully submit that the cited references are not properly combinable. Accordingly, Applicants submit that all pending claims are in condition for allowance. Favorable reconsideration of all pending claims is respectfully requested for at least the reasons discussed hereafter.

Independent Claims 1, 10, 23, 26, 35, 48, and 57 are Patentable

Independent Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the document entitled "Webhire Links Corporate Recruiting Desktops to Over 2,000 Job Posting Sites," March 2, 2000 (hereinafter "Webhire") in view of the document entitled "Searching distributed collections with inference networks" 1995, by Callan et al. (hereinafter "Callan") and further in view of the document entitled "Artificial intelligence in accounting & business" September 1998, by Qureshi et al. (hereinafter "Qureshi").

Independent Claim 1 is directed to a method of selecting a job post site and has been reproduced, in part, below:

- obtaining at least one job post site selection criterion;
- automatically ranking a plurality of job post sites based on the at least one job post site selection criterion, comprising:
 - accessing a fact table that contains data relevant to the at least one job post site selection criterion; and
 - using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion; and
 - selecting the job post site from the plurality of job post sites based on the ranking of the plurality of job post sites.

Claims 10, 23, 26, 35, 48, and 57 include similar recitations. Thus, according to the recitations of the pending independent claims, a plurality of job post sites are automatically ranked based on at least one job post site selection criterion by accessing a fact table that contains data relevant to the at least one job post site

selection criterion and by using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion.

The Office Action acknowledges that Webhire does not teach or suggest the recitations directed to automatically ranking a plurality of job post sites, accessing a fact table, and using an inference engine. (Office Action, page 5). The Office Action does allege, however, that Callan provides the missing teachings and that Qureshi cites various benefits for using expert systems in a business environment. (Office Action, page 5). Applicants respectfully submit, however, that neither Webhire nor Callan includes any motivation or suggestion to modify Webhire as indicated in the Office Action.

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of

Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."

Applicants agree that Callan describes the use of an inference network to rank documents retrieved based on a search query. (Callan, paragraphs 14 - 29). Applicants further agree that Qureshi describes the use of expert systems in various business applications. (Qureshi, paragraphs 13 - 36). Applicants submit, however, that none of the cited references include any clear and particular evidence of why it would be desirable to use an inference engine for ranking job post sites. As acknowledged in the Office Action, "[t]he Examiner submits that there were various approaches to ranking search results by relevance at the time of Applicants's invention." (Office Action, page 5). The Office Action then asserts that it would be obvious to modify Webhire's disclosure with the teachings of Callan and Qureshi related to the use of expert systems. But Applicants can find no disclosure in either Callan or Qureshi that suggest it may be desirable to use an expert system to address the problem of selecting a job post site from among a plurality of job post site candidates. Callan's disclosure is confined to the field of ranking documents. Qureshi discloses several business applications that may make use of an expert system including investment analysis, financial planning, financial statement analysis, credit evaluation and fraud detection, generation of marketing reports, inventory and equipment tracking, shipping route selection, etc. in paragraphs 13 - 36. Conspicuously absent, however, is any mention in Qureshi of the desirability of using an expert system to select a job post site from among a plurality of job post site candidates. As the Office Action states that there are various approaches to ranking the results of a search (Office Action, page 5), and the cited references contain no clear and

particular evidence of why it would be desirable to use an expert system (as opposed to another technique) for the particular problem of selecting job post site from among a plurality of job post site candidates, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

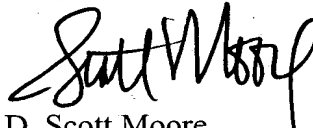
Accordingly, for at least the foregoing reasons, Applicants respectfully submit that independent Claims 1, 10, 23, 26, 35, 48, and 57 are patentable over the cited references and that Claims 3 - 9, 11 - 14, 16 - 22, 25, 28 - 34, 36 - 39, 41 - 47, 50 - 56, 58 - 61, 63 - 69 are patentable at least per the patentability of independent Claims 1, 10, 23, 26, 35, 48, and 57.

In re: Witte et al.
Serial No.: 09/677,993
Filed: October 3, 2000
Page 27 of 27

CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



D. Scott Moore
Registration No. 42,011

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 21, 2006.



Traci A. Brown